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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/874,162 | 06/04/2001 | Jason Koontz | 05311-024001 | 5882 |
| 26161 | 7590 | 09/10/2004 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | CANELLA, KAREN A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1642 | |

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,162

Applicant(s)

KOONTZ ET AL.

Examiner

Karen A Canella

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-31 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 20-31, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 33 is/are allowed.
- 6) ☐ Claim(s) 34 and 35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: attachment.

DETAILED ACTION

1. Claims 19, 32 and 38-42 have been canceled. Claims 33-35 have been amended. Claims 1-18, 20-31 and 33-37 are pending. Claims 1-18, 20-31, 36 and 37 remain withdrawn from consideration. It is noted that claims 36 and 37, now limited in part to SEQ ID NO:8, the only species now under consideration by virtue of the instant amendments, are not rejoined to the instant claims because of their dependence on canceled claim 32. Claims 33-35 are under consideration.

2. Text of Title 35, U.S. Code not found in this action can be found in a prior action.

3. Claim 35 is objected to for the typographical error or “comprising” rather than “comprises”. Appropriate correction is required.

4. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of claim 34 cannot be determined because said claims are dependent upon canceled claim 32. For purpose of examination, claim 34 will be read as dependent upon claim 33.

5. Claims 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Nagase et al (DNA Research, 1995, Vol. 2, pp. 167-174) as evidenced by the attached sequence alignment.

Claim 35 is drawn to a JAZ polypeptide which comprises a sequence that is 100% identical with a continuous portion of SEQ ID NO:8, said portion being at least 80% of said SEQ ID NO:8.

Nagase et al disclose the amino acid sequence of KIAA0160, as evidenced by the attached sequence alignment (Result 1), wherein the KIAA0160 sequence comprises a continuous portion of SEQ ID NO:8 from residue 130-776, said portion being 83% of SEQ ID NO:8.

6. All other rejections and objections as set forth in the previous Office action are withdrawn in light of applicants amendment of the claims canceling the first elected species.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10 a.m. to 9 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571)272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

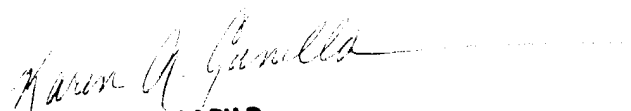
Karen A. Canella, Ph.D.

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9/7/2004


KARENA CANELLA PH.D
PRIMARY EXAMINER